

Application No. 10/821,423
Amendment dated January 25, 2005
Reply to Office action of November 19, 2004

REMARKS:**Status Of Claims**

Claims 1-36 were previously pending in the application. Claims 10 and 15 have been amended. Claims 37-40 have been added. Thus, claims 1-40 are currently pending in the application with claims 1, 10, 15, 23, 31, and 37 being independent.

Office Action

In the office action, the Examiner rejected claims 1, 2, 7, 8, 10, and 12 under 35 U.S.C. 103(a) as being unpatentable over Turetzky et al., U.S. Patent No. 6,529,829. The Examiner also rejected claims 3-5 under 35 U.S.C. 103(a) as being unpatentable over Turetzky et al. in view of Hakala et al., U.S. Patent No. 6,452,544. The Examiner also rejected claim 6 under 35 U.S.C. 103(a) as being unpatentable over Turetzky et al. in view of Horvitz et al., U.S. Patent No. 6,601,012. The Examiner also rejected claims 9, 13-16, 23-32, 34, and 35 under 35 U.S.C. 103(a) as being unpatentable over Turetzky et al. in view of DeLorme et al., U.S. Patent No. 6,321,158. Applicant respectfully submits that the currently pending claims distinguish the present invention from Turetzky, Hakala, Horvitz, DeLorme, and the other prior art references of record, taken alone or in combination with each other.

Specifically, claim 1 now recites "providing a first device including a triangulation positioning functionality" and "providing a second device to communicate with the first device, but separate from the first device, the second device including a dead reckoning

Application No. 10/821,423
Amendment dated January 26, 2005
Reply to Office action of November 19, 2004

positioning functionality". As shown in figures 5A and 5B, the first device 502 may be physically separate from the second device 510. Furthermore, as stated on page 17, lines 15-17, "the second navigation device 510 ... can be **removably** situated in the first mobile navigation device 502", emphasis added. Continuing to page 18, lines 10-11, "the first navigation device includes a handheld, portable navigation device in the form of a cradle which can be removably positioned in a vehicle". See also page 21, lines 5-18. Although, as stated on page 17, lines 18-27, "the terms first and second navigation devices, as used herein, are employed to distinguish attributes of one navigational device in relation to another". Thus, claim 1 requires one device having "triangulation positioning functionality" and another separate device "to communicate with the first device" having "dead reckoning functionality that includes an orientation component and a distance detection component".

In contrast, Turetzky's dead reckoning system is integral to his GPS enabled device. The two are simply not physically separable. For example, as disclosed in column 3, lines 26-27, "[a] dead reckoning system in accordance with the present invention [comprises] a GPS receiver and at least one sensor". While not identified with a numeral, Turetzky uses the term "sensor" exclusively in reference to a dead reckoning sensor. Referring to Turetzky's figure 1, a box labeled sensor, but not identified by a numeral, feeds into a CPU 110 of Turetzky's GPS receiver system 100. Finally, in figure 1, Turetzky's GPS receiver and dead reckoning sensor are shown on the same side of a dashed line that separates potentially separable components. Thus, Turetzky's dead reckoning sensor is integral to and not separable from his GPS receiver system 100.

Application No. 10/821,423
Amendment dated January 26, 2005
Reply to Office action of November 19, 2004

Furthermore, in column 5, lines 31-47, Turetzky discloses that the GPS receiver system 100 and the cellular telephone system 120 preferably share circuitry and both may even "be located on a single integrated circuit". As disclosed in column 5, lines 37-42, "for example, the GPS receiver system 100 can use the Central Processing Unit (CPU) 126 of the wireless transceiver 122 ... either instead of or in parallel with CPU 110". Thus, Turetzky prefers to integrate even those components that might be separable, and therefore teaches away from the separation of the present invention. As a result, Turetzky simply does not disclose, suggest, or make obvious "providing a first device including a triangulation positioning functionality" and "providing a second device to communicate with the first device, but separate from the first device, the second device including a dead reckoning positioning functionality", as claimed in claim 1.

Obviousness, it will be appreciated, can be a problematic basis for rejection because the Examiner, in deciding that a feature is obvious, has benefit of the Applicant's disclosure as a blueprint and guide, whereas one with ordinary skill in the art would have no such guide, in which light even an exceedingly complex solution may seem easy or obvious. Furthermore, once an obviousness rejection has been made, the Applicant is in the exceedingly difficult position of having to prove a negative proposition (i.e., non-obviousness) in order to overcome the rejection. For these reasons, MPEP § 2142 places upon the Examiner the initial burden of establishing a *prima facie* case which requires, among other things, that there be identified some motivation or suggestion in the prior art or in the knowledge of one with ordinary skill to modify the reference or to combine

Application No. 10/821,423
Amendment dated January 26, 2005
Reply to Office action of November 19, 2004

reference teachings. If the Examiner fails to establish the requisite *prima facie* case, the rejection is improper and will be overturned. *In re Rijckaert*, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). Only if the Examiner's burden is met does the burden shift to the applicant to provide evidence to refute the rejection.

Specifically, the Examiner must satisfy three criteria in order to establish the requisite *prima facie* case of obviousness: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine their teachings; (2) there must be a reasonable expectation of success; and (3) the prior art reference (or combination of references) must teach or suggest all the claim limitations. MPEP §706.02(j), citing *In re Vaeck*, 20 USPQ2d 1438 (Fed. Cir. 1991).

In meeting this initial burden, the Examiner "cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention". *In re Fine*, 5 USPQ 2d 1596, 1600 (Fed. Cir. 1988). The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on the applicant's disclosure. *In re Vaeck*, 1442 (Fed. Cir. 1991). Thus, measuring a claimed invention against the standard established by section 103 requires the oft-difficult but critical step of casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. See e.g., *W. L. Gore & Assoc., Inc. v. Garlock, Inc.*, 220 USPQ 303, 313 (Fed. Cir. 1983).

Application No. 10/821,423
Amendment dated January 26, 2005
Reply to Office action of November 19, 2004

Furthermore, "[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." *In re Fritch*, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992); see also *In re Gordon*, 221 USPQ 1125, 1127 (Fed. Cir. 1984). Additionally, "the mere possibility that one [element] could be modified or replaced ... does not make the [claim] obvious 'unless the prior art suggested the desirability of [such a] modification' or replacement". *In re Brouwer*, 37 USPQ2d 1663 (Fed. Cir. 1995) (citing *In re Gordon*).

In the present case, the prior art references made of record do not teach or suggest each of the claimed limitations. For example, Turetzky does not teach or suggest one navigation device being physically separable from a complementary navigation device. As discussed above, Turetzky actually teaches just the opposite, with a preference to combine multiple components on one integrated circuit. Furthermore, the prior art references made of record do not supply any suggestion or motivation to combine their teachings. Rather, as discussed above, Turetzky teaches away from such modification. As a result, the present obviousness rejections simply cannot be sustained.

Similarly, claim 10 now recites "providing a first mobile device including a triangulation positioning functionality" and "providing a second mobile device to communicate with the first mobile device and physically separable therefrom, the second mobile device including a 'dead reckoning functionality that includes an orientation component and a distance detection component". Thus, claim 10 requires that one device

Application No. 10/821,423
Amendment dated January 26, 2005
Reply to Office action of November 19, 2004

have "triangulation positioning functionality" and another device be "physically separable therefrom" and have "dead reckoning functionality that includes an orientation component and a distance detection component".

In contrast, as discussed above with respect to claim 1, Turetzky does not disclose two physically separable devices, one with triangulation capability and another with dead reckoning capability. In fact, Turetzky actually teaches away from such separability. As a result, Turetzky simply does not disclose, suggest, or make obvious "providing a first mobile device including a triangulation positioning functionality" and "providing a second mobile device to communicate with the first mobile device and physically separable therefrom, the second mobile device including a dead reckoning functionality that includes an orientation component and a distance detection component", as claimed in claim 10.

Claim 12 recites "retrieving navigation related data from a memory of the second mobile device and displaying the navigation related data on an integral display of the first mobile device". Claim 12 depends from claim 10. Thus, claim 12 not only requires the first and second device to be separable, but also requires that one device store navigation data and the other display that navigation data. Thus, not only are GPS and dead reckoning functions separated, so too are the storage and display of navigation data.

In contrast, Turetzky discloses no such functionality. Turetzky does not even suggest the possibility of storing navigation data in one device and displaying that data on another device. As a result, Turetzky simply does not disclose, suggest, or make obvious "retrieving navigation related data from a memory of the second mobile device and

Application No. 10/821,423
Amendment dated January 28, 2005
Reply to Office action of November 19, 2004

displaying the navigation related data on an integral display of the first mobile device", as claimed in claim 12.

Claim 15 recites "tracking a location of a first device using a triangulation positioning functionality" and "using a second device to communicate with the first mobile device, that is physically separable therefrom, and that includes a distance determination component and an orientation component". Thus, as in claims 1 and 10, claim 15 requires two physically separable units, one with triangulation capability and another with dead reckoning capability.

In contrast, as discussed above with respect to claim 1, Turetzky does not disclose two physically separable units, able to communicate with each other, one having triangulation capability and another having dead reckoning capability.

Alternatively, DeLorme discloses a GPS receiver used interchangeably with a dead reckoning system, rather than together as claimed in claim 15. For example, DeLorme discloses, in column 11, line 64, "FIG. 1A1 illustrates the portable PDA component". As disclosed in column 12, lines 63-64, "FIG. 1A1 also shows connection of a portable IRMIS device to a GPS". Finally, as disclosed in column 13, lines 6-8, "[a]lternative position-sensing devices include loran, other radio location, dead-reckoning, and hybrid systems". Thus, DeLorme's PDA device 02,102 can accept *either* a GPS system 08 or a dead reckoning system, not shown, but not both. Therefore, DeLorme's GPS system simply cannot communicate with his dead reckoning system. In fact, DeLorme actually teaches away from using his GPS system and dead reckoning system together. As a result, no

Application No. 10/821,423
Amendment dated January 26, 2005
Reply to Office action of November 19, 2004

combination of Turetzky and/or DeLorme discloses, suggests, or makes obvious "tracking a location of a first device using a triangulation positioning functionality" and "using a second device to communicate with the first mobile device and physically separable therefrom that includes a distance determination component and an orientation component", as claimed in claim 15.

It should be noted that the Examiner did not directly address the limitations found in claims 17-22. Applicant believes that the prior art made of record, alone or in combination, fails to disclose, suggest, or make obvious the limitations of claims 17-22.

For example, claim 17 recites "wherein using a second navigation device to continue tracking the location includes using a handheld, portable second device, wherein the handheld, portable second device includes a cradle for the first device". It should be noted that claim 17 depends from claim 15. As disclosed in the present application and discussed above with respect to claim 1, one of the devices of the present invention may form a cradle for the other device. Thus, claim 17 requires that the second device include dead reckoning functionality and form a cradle for the first device, which includes triangulation functionality.

In contrast, neither Turetzky nor DeLorme disclose one navigation device forming a cradle for another navigation device. While DeLorme does disclose a cradle 02,102, his cradle is strictly designed to provide communications between his PDA 06,106 and his desktop computer 105. DeLorme's cradle 02,102 simply does not include any navigation capability, much less the "a distance determination component and an orientation

Application No. 10/821,423
Amendment dated January 26, 2005
Reply to Office action of November 19, 2004

component", as required by claims 15 and 17. As a result, no combination of Turetzky and/or DeLorme discloses, suggests, or makes obvious "wherein using a second navigation device to continue tracking the location includes using a handheld, portable second device, wherein the handheld, portable second device includes a cradle for the first device", as claimed in claim 17.

Claim 19 recites "software operable on the first and the second devices for selecting between using the first and the second devices". Claim 21 depends from claim 19 and recites "wherein selecting between using the first and the second devices includes resolving which of the first and the second devices is providing a better set of position data". Thus, claims 19 and 21 require software to select which one of the devices will be used to determine position and that the software base such selection on which device is providing better data.

In contrast, Turetzky simply does not disclose how any 'selection' between GPS and dead reckoning is made. Furthermore, Turetzky's dead reckoning sensor may only be used as a supplement to, not a replacement for his GPS receiver.

As discussed above, DeLorme's GPS system is interchangeable with his dead reckoning system. However, to use one over the other, a user must disconnect one before connecting the other. Therefore, DeLorme requires the user to make the selection, rather than software making the selection. Furthermore, DeLorme completely lacks any disclosure with regard to how such selection may be made. As a result, no combination of Turetzky and/or DeLorme discloses, suggests, or makes obvious software "selecting

Application No. 10/821,423
Amendment dated January 26, 2005
Reply to Office action of November 19, 2004

between using the first and the second devices", as claimed in claim 19, much less that software "resolving which of the first and the second devices is providing a better set of position data", as claimed in claim 21.

Claim 23 recites "a first mobile device including a dead reckoning positioning component" and "a second mobile device removably situated in the first mobile device including a triangulation positioning functionality in communication with the first mobile device". As discussed above with respect to claims 1 and 17, the second device includes navigation functionality and provides a cradle to selectively support the first device which also provides navigation functionality.

In contrast, as discussed above with respect to claim 17, neither Turetzky nor DeLorme disclose a similar combination of functionality. As a result, no combination of Turetzky and/or DeLorme discloses, suggests, or makes obvious "a first mobile device including a dead reckoning positioning component" and "a second mobile device removably situated in the first mobile device including a triangulation positioning functionality in communication with the first mobile device", as claimed in claim 23.

Claim 26 recites "wherein the first mobile device further includes a triangulation positioning functionality, and the second device further includes a dead reckoning positioning component". Since claim 26 depends from claim 23, claim 26 actually requires both devices to include both triangulation and dead reckoning functionality. In contrast, neither Turetzky nor DeLorme disclose two devices, communicating with each other that each include both triangulation and dead reckoning functionality. As a result, no

Application No. 10/821,423
Amendment dated January 26, 2005
Reply to Office action of November 19, 2004

combination of Turetzky and/or DeLorme discloses, suggests, or makes obvious the limitations claimed in claim 26.

Claim 29 recites "wherein the second mobile device is removably, physically interfaced to the first mobile device". As discussed above, Turetzky's GPS receiver is integral with his dead reckoning sensor, and are therefore not "removably, physically interfaced" to each other. Also as discussed above, DeLorme's GPS system is interchangeable with his dead reckoning system, and therefore not interfaced with each other at all. As a result, no combination of Turetzky and/or DeLorme discloses, suggests, or makes obvious the limitations claimed in claim 29.

Claim 30 recites "wherein the first and second mobile devices are wirelessly interfaced with one another". In contrast, as discussed above, Turetzky's GPS receiver is integral with his dead reckoning sensor, and therefore not "wirelessly interfaced with one another". In fact, Turetzky's disclosed wireless interface is beyond, not between, his combination GPS receiver and dead reckoning sensor. Also as discussed above, DeLorme's GPS system is interchangeable with his dead reckoning system, and therefore not interfaced with each other at all. As a result, no combination of Turetzky and/or DeLorme discloses, suggests, or makes obvious the limitations claimed in claim 30.

Claim 31 recites "a first device having a processor, a memory, and a transceiver ... including a positioning function", "a second device having a processor, a memory, and a transceiver to communicate with one another, the second device including a positioning functionality", "wherein the transceivers in the first and the second devices transmit

Application No. 10/821,423
Amendment dated January 26, 2005
Reply to Office action of November 19, 2004

navigation related data wirelessly between the first and the second devices", and "wherein the first and the second devices cooperate to resolve a position of the first and the second devices". As discussed at length above, no combination of Turetzky and/or DeLorme discloses, suggests, or make obvious two separate positioning devices that wirelessly communicate with one another and cooperate to resolve a position, as claimed in claim 31.

Claim 33 recites "wherein the first and the second devices resolve the position using the GPS functionality while a GPS signal service is available to the first device, and wherein one of the first and the second devices resolve the position using the dead reckoning positioning functionality to supplement the GPS functionality when one of an interrupted, and unavailable GPS signal service is indicated by the first device". Claim 33 depends, indirectly, from claim 31. As discussed at length above, neither Turetzky nor DeLorme disclose, suggest, or make obvious two separate positioning devices that wirelessly communicate with one another and cooperate to resolve a position, as claimed in claim 31, much less the manner of that cooperation, as claimed in claim 33.

Claims 37-40 have been added to further distinguish the present invention over the prior art. The remaining claims all depend directly or indirectly from independent claims 10, 15, 23, or 31, and are therefore also allowable.

Application No. 10/821,423
Amendment dated January 26, 2005
Reply to Office action of November 19, 2004

Any additional fee which is due in connection with this amendment should be applied against our Deposit Account No. 501-791. In view of the foregoing, a Notice of Allowance appears to be in order and such is courteously solicited.

Respectfully submitted,

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